

### **REMARKS**

The Examiner is thanked for the thorough examination of the present application. The Office Action mailed September 20, 2006 tentatively rejected claims 1-25. This is a full and timely response to that outstanding Office Action. Upon entry of the amendments in this response, claims 1-25 are pending.

#### **I. Present Status of Patent Application**

Claims 14-25 are rejected under 35 U.S.C. 101 because the claimed invention is allegedly directed to non-statutory subject matter. Claims 1-25 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *La Pierre* (U.S. Patent No. 5,951,611) in view of *Glowny, et al.* (U.S. Patent No. 5,491,791). These rejections are respectfully traversed.

#### **II. Rejections Under 35 U.S.C. §101**

The Office Action rejects claims 14-25 under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter. Regarding claim 14, the Office Action alleges that “[a] module configured to perform a method is merely a software arrangement.” See Office Action, page 2. However, each of a rang estimation module, a verifier module, and a distance estimation module may be embodied by a hardware module for performing the cited function. Non-limiting embodiments of these system modules are disclosed, where logic is implemented in hardware, on page 7, lines

12-18 of the specification. Therefore, Applicant respectfully submits that the rejections to independent claim 14 and dependent claims 15-25 should be withdrawn.

Regarding the rejections to claims 17 and 23-25, a database (computer program structure) claimed as part of an otherwise statutory manufacture or machine remains statutory irrespective of the fact that the database is included in the claim. See Interim Guidelines for Examination of Patent Application of Patent Subject Matter Eligibility, page 53. Applicant respectfully submits the base claim of claims 17 and 23-25 meet the statutory requirements of 35 U.S.C. §101. Therefore, dependent claims 17 and 23-25 also meet the statutory requirements of 35 U.S.C. 101 and the rejections should be withdrawn.

### III. Rejections Under 35 U.S.C. §103(a)

#### A. Claims 1-7

The Office Action rejects claims 1-7 under 35 U.S.C. §103(a) as allegedly being unpatentable over *La Pierre* (U.S. Patent No. 5,951,611) in view of *Glowny, et al.* (U.S. Patent No. 5,491,791). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Applicant respectfully submits the combination of the *LaPierre* and *Glowny* references is improper and the claims should be allowed over the references of record. *La Pierre* and *Glowny* are unrelated, and, therefore, one of ordinary skill in the art would not have combined them. The claims of the application recite a method for providing automated diagnosis of problems in a computer network. *La Pierre*, the primary

reference, is a diagnostic method for analyzing problems in an aircraft engine. *Glowny*, the secondary reference, is a method of inventorying and monitoring remote workstations in a distributed computing environment. Techniques for finding problems in an aircraft engine do not translate into techniques for finding problems in a computer network. Therefore, Applicant respectfully submits that the combination of the references is improper and the claims should be allowed. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 1 is allowable.

For at least the reason that independent claim 1 is allowable over the cited references of record, dependent claims 2-7 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-7 contain all the features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, the rejection to claims 2-7 should be withdrawn and the claims allowed.

B. Claims 8-13

The Office Action rejects claims 8-13 under 35 U.S.C. §103(a) as allegedly being unpatentable over *La Pierre* (U.S. Patent No. 5,951,611) in view of *Glowny, et al.* (U.S. Patent No. 5,491,791). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Applicant respectfully submits the combination of the *LaPierre* and *Glowny* references is improper and the claims should be allowed over the references of record. *La Pierre* and *Glowny* are unrelated, and, therefore, one of ordinary skill in the art would not have combined them. The claims of the application recite a method for providing automated diagnosis of problems in a computer network. *La Pierre*, the primary reference, is a diagnostic method for analyzing problems in an aircraft engine. *Glowny*, the secondary reference, is a method of inventorying and monitoring remote workstations in a distributed computing environment. Techniques for finding problems in an aircraft engine do not translate into techniques for finding problems in a computer network. Therefore, Applicant respectfully submits that the combination of the references is improper and the claims should be allowed. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 8 is allowable.

For at least the reason that independent claim 8 is allowable over the cited references of record, dependent claims 9-13 (which depend from independent claim 8) are allowable as a matter of law for at least the reason that dependent claims 9-13

contain all the features of independent claim 8. Therefore, the rejection to claims 9-13 should be withdrawn and the claims allowed.

C. Claims 14-25

The Office Action rejects claims 14-25 under 35 U.S.C. §103(a) as allegedly being unpatentable over *La Pierre* (U.S. Patent No. 5,951,611) in view of *Glowny, et al.* (U.S. Patent No. 5,491,791). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

Applicant respectfully submits that claim 14 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features of the claim at issue.

Applicant respectfully submits the combination of the *LaPierre* and *Glowny* references is improper and the claims should be allowed over the references of record. *La Pierre* and *Glowny* are unrelated, and, therefore, one of ordinary skill in the art would not have combined them. The claims of the application recite a method for providing automated diagnosis of problems in a computer network. *La Pierre*, the primary reference, is a diagnostic method for analyzing problems in an aircraft engine. *Glowny*, the secondary reference, is a method of inventorying and monitoring remote workstations in a distributed computing environment. Techniques for finding problems in an aircraft engine do not translate into techniques for finding problems in a computer network. Therefore, Applicant respectfully submits that the combination of the

references is improper and the claims should be allowed. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 14 is allowable.

For at least the reason that independent claim 14 is allowable over the cited references of record, dependent claims 15-25 (which depend from independent claim 14) are allowable as a matter of law for at least the reason that dependent claims 15-25 contain all the features of independent claim 14. Therefore, the rejection to claims 15-25 should be withdrawn and the claims allowed.

#### **IV. Miscellaneous Issues**

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

**CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-25 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

It is believed that no extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account No. 20-0778.

Respectfully submitted,

/BAB/

**Benjamin A. Balser, Reg. No. 58,169**

**THOMAS, KAYDEN,  
HORSTEMEYER & RISLEY, L.L.P.**  
Suite 1750  
100 Galleria Parkway N.W.  
Atlanta, Georgia 30339  
(770) 933-9500  
Customer No.: 38823